

Remarks

I. Status of the Claims

Upon entry of the present amendment, claims 1-2, 6, 12-33 and 65-70 will remain pending in this application. Applicants reserve the right to pursue any subject matter that is not now claimed in a continuing application. Claims 1-2, 6, 12 and 17 have been amended to make reference to a "feedstuff" in place of a "material." Support for this amendment appears in original claim 4. Claim 1 has also been amended to make reference to a "specific database" and to name certain components of the feedstuff. Support for these amendments appear in original claims 3 and 9-10. Further, new dependent claims 65-70 have been added. Support for these claims can be found in the original specification at, for example, page 12, paragraph 32 and pages 18-19, paragraphs 44-45.

The Examiner has taken "official notice" of certain principles in support of the rejections of the claims. Applicants do not acquiesce in those positions taken by the Examiner. As explained below, Applicants respectfully traverse the rejections for reasons separate and apart from any "official notice" taken by the Examiner.

II. First Rejection under 35 U.S.C. § 103(a)

Claims 1, 3-6, 8, 10-13, 19, 25-42, 44, 45, 51, 52, 57, 59 and 60 are rejected under 35 U.S.C. § 103(a) over WO 01/15548 to D'Alfonso et al. ("D'Alfonso") in view of US 2002/0138546 to Parsonnet et al. ("Parsonnet").

In the Office Action, it is asserted that D'Alfonso discloses comparing a near infrared reflectance spectrum ("NIRS") of a material to a known calibration in a database to determine the content level of different components in materials. However, the Examiner acknowledges that D'Alfonso does not disclose: 1) electronically receiving a request from a customer to predict the level of a component in a material and electronically reporting the prediction; 2) charging a fee for services to the customer; 3) exchanging the customer request and the prediction report on a web site; 4) reporting the prediction within 10 minutes of receiving a customer request or exchanging the customer request and prediction report 24 hours a day; 5) opening a customer account and providing the customer with security codes; or 6) storing the customer request, fee

information or prediction report so that the information may be retrieved by the customer on a web site. The Examiner concluded that Parsonnet discloses each of these numbered items and that it would have been obvious to combine the teachings of Parsonnet with those of D'Alfonso to provide customers with results of a NIRS test in a more efficient and less costly manner than sending physical samples for testing.

Applicants respectfully traverse the rejection as it applies to the claims now pending. Claim 1 is the only independent claim remaining in the application. Applicants address the rejection as it applies to claim 1, with the understanding that the arguments apply to the remaining claims just as well.

One skilled in the art would not have been motivated to combine the teachings of D'Alfonso and Parsonnet in the manner proposed by the Examiner to reach the claimed invention. D'Alfonso discloses the use of NIRS measurements (together with an established database) as a tool in the larger objective of making improved feedstuffs. The document states that the NIRS measurements are "fast" and "convenient" for establishing, for example, the amount of amino acids in a raw material. D'Alfonso at page 5, lines 2-3. Rather than suggesting any combination with systems disclosed in Parsonnet, the D'Alfonso appears to express satisfaction with what is already disclosed. The D'Alfonso application certainly does not express any discontent or other need to change the disclosed method of NIRS measurements used in conjunction with an established database of the user.

Parsonnet similarly lacks any suggestion to use its disclosed systems in conjunction with NIRS techniques. The "services" between customers and vendors in Parsonnet are "broadly defined to mean any activity or operation contributing to a solution," for example, "computer or automated services." Parsonnet at paragraph 49. While such a broad statement is made, Parsonnet certainly does not qualify as the "clear and particular" showing of evidence needed to support the combination of the document with the disclosure of NIRS techniques in D'Alfonso. See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Lastly, one of the Examiner's stated reasons for why the teachings would have been obvious to combine is that "customers would have had access to results of NIRS test in a more efficient and less costly manner than sending samples to be tested."

Office Action at page 3, lines 3-4. As explained above, however, the D'Alfonso disclosure in particular does not express discontent to spur one skilled in the art in the direction of the Parsonnet disclosure. Even if one skilled in the art had wanted to obtain results more efficiently or with less cost, surely any number of possibilities existed to do so apart from what has been claimed. In the final analysis, improper hindsight has been used in making the rejection, by citing the teachings of this application on the benefits of the invention as a rationale for combining the art in the way proposed. That analysis does not suffice to create a *prima facie* case of obviousness. See *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."). Applicants therefore respectfully request that the Examiner withdraw this rejection.

III. Second Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claim 2 as unpatentable over D'Alfonso and Parsonnet as explained above in view of U.S. Patent No. 5,219,400 to Jacot et al. ("Jacot"). In the rejection, it is asserted that "D'Alfonso et al. and Parsonnet et al. teach all the limitations of claim 1" and that it would have been obvious to use the teachings of Jacot in combination with those documents to include a correlation between *in vitro* and *in vivo* measurements as claimed in claim 2. Office Action at page 6.

Applicants respectfully traverse this rejection. As explained above, one skilled in the art would not have been motivated to make the invention of claim 1 in view of D'Alfonso and Parsonnet. A premise of this second rejection, that claim 1 would have been obvious, therefore no longer applies. Furthermore, the teaching of an *in vitro* and *in vivo* correlation in Jacot does not provide the suggestion to make the invention of claim 1. Claim 2, which depends from claim 1, is therefore patentable as well. Applicants respectfully request that the Examiner withdraw this rejection.

IV. Third Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 7, 9, 43, 46 and 58 as unpatentable over D'Alfonso and Parsonnet as explained above in view of U.S. Patent No. 4,893,253 to Lodder. Applicants have canceled the rejected claims, rendering this rejection moot.

V. Fourth Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 14-18 as unpatentable over D'Alfonso and Parsonnet as explained above in view of U.S. Patent No. 5,991,739 to Cupps et al. ("Cupps"). In the Office Action, it is asserted that "D'Alfonso et al. and Parsonnet et al. teach all the limitations of claim 1" and that it would have been obvious to use the teachings of Cupps in combination with those documents to include exchanging the customer request the report using electronic mail and presenting menu options for selection by the customer. Office Action at page 7.

Applicants respectfully traverse this rejection. As explained above, one skilled in the art would not have been motivated to make the invention of claim 1 in view of D'Alfonso and Parsonnet. A premise of this present rejection, that claim 1 would have been obvious, therefore no longer applies. Furthermore, the teachings of exchanging a customer request and report by electronic mail and offering menu options to the customer do not provide the suggestion to make the invention of claim 1. Claims 14-18, which depend from claim 1, are therefore patentable as well. Applicants respectfully request that the Examiner withdraw this rejection.

VI. Fifth Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 20-24, 47-50, 53-56 and 61-64 as unpatentable over D'Alfonso and Parsonnet as explained above in view of U.S. Patent No. 5,729,740 to Tsumura. In the rejection, it is asserted that "D'Alfonso et al. and Parsonnet et al. teach all the limitations of claim 1" and that it would have been obvious to use the teachings of Tsumura in combination with those documents to include certain fee arrangements with the customer. Office Action at page 8.

Applicants have canceled claims 47-50, 53-56 and 61-64, rendering the rejection of those claims moot. Further, Applicants traverse the rejection as it applies to claims 20-24. As explained above, one skilled in the art would not have been motivated to

make the invention of claim 1 in view of D'Alfonso and Parsonnet. A premise of this present rejection, that claim 1 would have been obvious, therefore no longer applies. Furthermore, the teachings of certain fee arrangements do not provide the suggestion to make the invention of claim 1. Claims 20-24, which depend from claim 1, are therefore patentable as well. Applicants respectfully request that the Examiner withdraw this rejection.

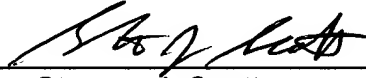
In view of these amendments and remarks, the pending claims should be in condition for allowance. The Examiner is also requested to examine and allow new claims 65-70.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 14, 2003

By: 
Steven. J. Scott
Reg. No. 43,911